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EXAMINER	
VAN HANDEL, MICHAEL P	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/910,656	WATTS ET AL.	
	Examiner	Art Unit	
	MICHAEL VAN HANDEL	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,3,6,7,9,10,14,15,18,20-22,26,29-31,33-37 and 44-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,3,6,7,9,10,14,15,18,20-22,26,29-31,33-37 and 44-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 10/20/2009. Claims **2**, **3**, **6**, 7, **9**, **10**, **14**, **15**, **18**, **20-22**, **26**, **29-31**, **33-37**, **44-46** are pending. Claims **2**, **3**, **6**, 7, **9**, **10**, **14**, **15**, **18**, **20-22**, **26**, **29-31**, **33-37** are amended. Claims **1**, **4**, **5**, **8**, **11-13**, **16**, **17**, **19**, **23-25**, **27**, **28**, **32**, **38-43** are canceled. Claims **44-46** are new.

Response to Arguments

2. Applicant's arguments regarding claim **46**, filed 10/20/2009, have been considered, but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments regarding claims **44** and **45**, filed 10/20/2009, have been fully considered, but they are not persuasive.

Regarding claims **44** and **45**, the applicant appears to argue that Shoff et al. does not teach storing a plurality of portions of subsidiary data in a storage database and providing a user interface for accessing that storage. The examiner respectfully disagrees. Shoff et al. discloses that a content author constructs a target resource with supplemental content and HTML tags and stores it in a storage medium at a host computer (col. 14, l. 30-36). The examiner interprets the host computer to be a "subsidiary data control," as currently claimed. A target specification is generated for referencing the location where the target resource is stored and the target specification is transmitted to the EPG provider and integrated into the EPG (col. 14, l. 31-40). When a user views the corresponding video program, the target specification is accessed and the

target resource is retrieved from the host computer, resulting in displays such as those shown in Figures 8b and 8c (col. 9, l. 54-67; col. 10, l. 1-6; & Figs. 8b, 8c). The examiner interprets these to be a "user interface," as currently claimed. Through the selection of buttons 212-221, the user can access additional supplemental material from the storage database (col. 11, l. 1-47). As such, the examiner maintains that Shoff et al. teaches storing a plurality of portions of subsidiary data in a storage database and providing a user interface for accessing that storage, as currently claimed.

Additionally, Shoff et al. discloses that the content author can create a CD-ROM and provide it to the user. The CD-ROM contains the target resource to be played along with the program. The examiner interprets the STB storing the CD-ROM to be a "subsidiary data control," as currently claimed. As noted above, once within the target resource, the user can access additional supplemental material from the storage using a user interface. As such, this interpretation also teaches storing a plurality of portions of subsidiary data in a storage database and providing a user interface for accessing that storage, as currently claimed. Applicant argues that the supplemental content of Shoff et al. is accessed concurrently with the program, while that of the instant application is not. The examiner fails to find any language in either claim 44 or claim 45 that suggests that the supplemental content is not accessed concurrently with the program.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims **14**, **15**, **18**, **20-22**, **45** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Claim **45** is directed towards a tangible machine-readable medium; however, Applicant's specification states that the series of instructions can be stored using any conventional storage medium, such as a diskette, CD-ROM, magnetic tape, DVD, laser disk, ROM, Flash memory, etc. and that the instructions could be received from a remote storage device via a network/communication interface (p. 25, lines 11-15). This implies that the tangible machine-readable medium can be a signal. The examiner notes that a claim directed to a signal *per se* is not a process, machine, manufacture, or composition of matter. The examiner recommends that the preamble of the claim be amended to recite "[a] non-transitory tangible machine-readable medium." See **MPEP 2106.01** for guidance.

Claims **14**, **15**, **18**, and **20-2**2 are rejected as being dependent on claim 45.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims **2**, **3**, **6**, **7**, **9**, **10**, **14**, **15**, **18**, **20-22**, **44**, **45** are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al. (of record).

Referring to claim **2**, Shoff et al. discloses the method of claim 44, wherein receiving the plurality of portions includes receiving the plurality of portions from the external source prior to beginning receipt of the primary content data (col. 7, l. 61-67 & col. 8, l. 1-3).

Referring to claim **3**, Shoff et al. discloses the method of claim 2, wherein retrieving the identified portion of the plurality of subsidiary data comprises obtaining the identified portion from the storage, wherein the storage is a local nonvolatile storage medium of a set-top system (CD-ROM)(col. 7, l. 61-67 & col. 8, l. 1-3).

Referring to claim **6**, Shoff et al. discloses the method of claim 44, wherein the primary content data comprises data of at least one of a television broadcast (col. 2, l. 62-63), a digital satellite broadcast (col. 5, l. 3), an Internet broadcast, and an audio-only broadcast.
NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **7**, Shoff et al. discloses the method of claim 44, wherein transmitting a representation of a user interface comprises transmitting a representation of a user interface that further facilitates entry of one or more search terms for searching the storage to locate one or more portions of subsidiary data (col. 11, l. 25-47 & Figs. 8b, 8c).

Referring to claim **9**, Shoff et al. discloses the method of claim 44, further comprising retrieving, by the subsidiary data control, the subsidiary data from a remote server (col. 14, l. 30-41).

Referring to claim **10**, Shoff et al. discloses the method of claim 44, the identified portion comprises at least one of reference information regarding a program of the primary content data

(col. 11, l. 25-33), biographical information regarding actors (col. 11, l. 25-33), guests or participants of a program of the primary content data (col. 11, l. 25-33).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **14**, Shoff et al. discloses the machine-readable medium of claim 45, wherein the instructions are further configured to cause the set-top system to store the identified subsidiary data locally in the set-top system (col. 7, l. 61-67 & col. 8, l. 1-3).

Referring to claim **15**, Shoff et al. discloses the machine-readable medium of claim 14, wherein the method further comprises receiving the plurality of portions of subsidiary data prior to beginning receiving the primary content data (col. 7, l. 61-67 & col. 8, l. 1-3).

Referring to claim **18**, Shoff et al. discloses the machine-readable medium of claim 45, wherein the method further comprises facilitating entry, through the user interface, of one or more search terms for searching the storage to locate a portion of subsidiary data (col. 11, l. 25-47).

Referring to claim **20**, Shoff et al. discloses the machine-readable medium of claim 45, wherein the instructions are further configured to cause the set-top system to retrieve the identified subsidiary data from a remote server (from a service provider)(col. 9, l. 23-26).

Referring to claim **21**, Shoff et al. discloses the machine-readable medium of claim 45, wherein the portions of subsidiary data comprise at least one of reference information regarding a program of the primary content data (col. 11, l. 25-33), biographical information regarding the actors (col. 11, l. 25-33), guests or participants of a program of the primary content data (col. 11, l. 25-33).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **22**, Shoff et al. discloses the machine-readable medium of claim 18, wherein the method further comprises retrieving the located portion of subsidiary data independently of the primary content data (based on user selection)(col. 11, l. 25-47).

Referring to claim **44**, Shoff et al. discloses a method comprising:

- receiving, at a subsidiary data control, a plurality of portions of subsidiary data from an external source for storing at a storage (content author constructs a target resource with a plurality of events or user receives a CD-ROM with plurality of events)(col. 7, l. 61-67; col. 13, l. 23-67; & col. 14, l. 1-40), the portions including respective time values corresponding to times within a duration of a video content program encoded by primary content data (each EVENT references a TRIGGER that defines the time the EVENT is to occur)(col. 7, l. 61-67; col. 8, l. 1-3; col. 13, l. 50-67; & col. 14, l. 25-30), the time values identifying respective portions of subsidiary data as being associated with corresponding time segments of the primary content data (when a TRIGGER occurs, the EVENT determines the ACTION to be taken, which references a URL to a resource or object to occur at that time)(col. 7, l. 67; col. 8, l. 1-3; col. 13, l. 50-67; & col. 14, l. 25-30), the primary content data to be displayed over a plurality of time segments (col. 8, l. 1-3; col. 10, l. 50-58; col. 11, l. 59-65; & Figs. 8b, 8c) and the subsidiary data being received separately from the primary data (over separate network or via CD-ROM)(Fig. 4);

- transmitting, by the subsidiary data control, a representation of a user interface to a display device, wherein the user interface is configured to facilitate accessing the storage, identifying a portion of the subsidiary data, and retrieving the identified portion (soft buttons enable the user to select different types of supplemental content associated with the program)(col. 10, l. 59-67; col. 11, l. 1-47; & Figs. 8b, 8c); and
- generating, by the subsidiary data control, an output signal that causes the display device to present visually the identified portion of the subsidiary data, the identified portion being received and retrieved independently of receiving the primary content data (layout template is defined by the digital data of the target resource)(col. 11, l. 48-65 & Figs. 4, 8b, 8c).

Referring to claim **45**, Shoff et al. discloses a tangible machine-readable medium having stored thereon programming code comprising instructions to, in response to being cause a set-top system to perform a method comprising:

- receiving a plurality of portion of subsidiary data from an external source for storing at a storage (content author constructs a target resource with a plurality of events or user receives a CD-ROM with plurality of events)(col. 7, l. 61-67; col. 13, l. 23-67; & col. 14, l. 1-40), the portions including respective time values corresponding to times within a duration of a video content program encoded by primary content data (each EVENT references a TRIGGER that defines the time the EVENT is to occur)(col. 7, l. 61-67; col. 8, l. 1-3; col. 13, l. 50-67; & col. 14, l. 25-30), the time values respectively identifying corresponding portions of subsidiary data as being associated with corresponding time segments of the primary content data (when a TRIGGER

occurs, the EVENT determines the ACTION to be taken, which references a URL to a resource or object to occur at that time)(col. 7, l. 67; col. 8, l. 1-3; col. 13, l. 50-67; & col. 14, l. 25-30), the primary content data to be displayed over a plurality of time segments (col. 8, l. 1-3; col. 10, l. 50-58; col. 11, l. 59-65; & Figs. 8b, 8c), the subsidiary data being received separately from primary data (over separate network or via CD-ROM)(Fig. 4);

- transmitting a representation of a user interface to a display device, wherein the user interface is configured to facilitate accessing of the storage, identifying a portion of the subsidiary data, and retrieving the identified portion of the subsidiary data (soft buttons enable the user to select different types of supplemental content associated with the program)(col. 10, l. 59-67; col. 11, l. 1-47; & Figs. 8b, 8c); and
- generating an output signal that causes the display device to present visually the identified portion of the subsidiary data, the identified portion being received and retrieved independently of receiving the primary content data (layout template is defined by the digital data of the target resource)(col. 11, l. 48-65 & Figs. 4, 8b, 8c).

8. Claims **29**, **30**, **31**, **34-36**, **46** are rejected under 35 U.S.C. 102(e) as being anticipated by Matthews, III et al.

Referring to claim **29**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the storage database includes an identification of a remote server from which subsidiary data may be retrieved (Fig. 2) and wherein the controller is configured to request retrieval of the subsidiary data from the identified remote server (col. 10, l. 27-32).

Referring to claim **30**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the plurality of portions of subsidiary data comprises at least one of reference information regarding a program of the primary content data (col. 7, l. 15-20), biographical information regarding the actors, guests or participants of a program of the primary content data. NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **31**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the controller is further configured to retrieve the portion of subsidiary data in response to input of a search term, the search term being input through a user interface (col. 10, l. 18-33, 54-57).

Referring to claim **34**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the controller is further configured to receive and store the subsidiary data in the storage database (col. 7, l. 30-41 & col. 10, l. 3-11).

Referring to claim **35**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the controller is further configured to provide the user interface to allow a searching of the storage database with one or more search terms (col. 10, l. 18-33, 54-57).

Referring to claim **36**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the controller is further configured to provide access to a programming guide (col. 8, l. 50-65 & Fig. 5).

Referring to claim **37**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the controller is further configured to provide a user interface allowing input for toggling between display of the subsidiary data and display of the primary content data (the

viewer can select between the program itself and its supplemental content within the EPG)(col. 9, l. 24-31 & col. 10, l. 18-33).

Referring to claim **46**, Matthews, III et al. discloses an entertainment system (Fig. 1) comprising:

- a data receiver configured to receive a plurality of portions of subsidiary data from an external source for storing (supplemental content can be pre-cached at the receiver)(col. 7, l. 8-20, 30-35; col. 10, l. 3-8, 13-17; & col. 11, l. 31-35), the portions including respective time values corresponding to times within a duration of a video content program encoded by primary content data (associated with the program time)(Figs. 2, 5), the time values respectively identifying a corresponding portion of subsidiary data as being associated with a time segment of the primary content data (http://www/fox/com/startrek.html & http://www.collections.com/trekkicollectables.html are associated with 10:00 PM showing of Star Trek; Hitler, Pearl Harbor, and A-Bomb resources are associated with 8:00 PM showing of WW II Documentary)(Figs. 2, 5), the primary content data to be displayed over a plurality of time segments (Figs. 2, 5) and the subsidiary data received separately from the primary content data (Fig. 3);
- a storage database configured to store the plurality of portions of subsidiary data prior to receipt of the primary content data, the portions including the corresponding time values (col. 10, l. 3-8 & Fig. 2); and
- a controller coupled to the data receiver and the storage database to retrieve a portion of the subsidiary data and forward the portion to a display prior to receiving the

primary content data, the portion being retrieved in response to input received through a user interface (col. 10, l. 4-8; col. 12, l. 15-26; & Fig. 5) the input selecting the portion of subsidiary data for display independently of the primary content data (Fig. 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim **26** is rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al.

Referring to claim **26**, Matthews, III et al. discloses the entertainment system of claim 46, wherein the storage database is stored in a local storage medium (local cache)(col. 10, l. 3-8). Matthews, III et al. does not specifically disclose that the local cache is a nonvolatile storage medium; however, the examiner takes Official Notice that it is notoriously well-known within the prior art to store data in a nonvolatile storage, such as a hard disk. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the cache memory of Matthews, III et al. to be a nonvolatile memory, such as that taught by the prior art in order to provide a more persistent storage medium for keeping data safe from unintended deletion.

11. Claim **33** is rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al. in view of Shoff et al. (of record).

Referring to claim **33**, Matthews, III et al. discloses the entertainment system of claim 46. Matthews, III et al. does not specifically disclose a second controller coupled to the controller to combine the primary content data with the identified subsidiary data and forward the combined data to the display. Shoff et al. discloses integrating video content with Internet content received from a URL target resource into a single screen and outputting the screen to a display (col. 6, l. 7-29; col. 9, l. 54-59; col. 10, l. 59-60; & Figs. 8b, 8c). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the separate display of video content and web content associated with the video content taught by Matthews, III et al. to combine them into a single display, such as that taught by Shoff et al. in order to provide a more fun and sensory rich viewing environment for watching a video program (Shoff et al. col. 1, l. 26-33).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit 2424

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